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10/654,795	09/03/2003	Richard J. Sacks	P1425	6963

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EXAMINER

DESAI, ANISH P

ART UNIT PAPER NUMBER

1771

DATE MAILED: 09/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/654,795

Applicant(s)

SACKS, RICHARD J.

Examiner

Anish Desai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 30-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 30-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

The applicant's arguments in response to the Office action dated 02/21/06 have been fully considered.

1. Claims 1-29 are cancelled. Claims 30-33 are newly added.
2. 112 rejections of claims 22,25, and 29 are moot because these claims are cancelled.
3. All of the art rejections are moot because claims 1-29 are cancelled.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiles (US 4,808,469) in view of Bryant et al. (US 5,366,801), and further in view of Widdemer (US Patent Application Publication 2002/0035755).

With respect to the recitation "for use in contact with flesh of an animal", note that the claim preamble must be read in the context of the entire claim. The determination of whether preamble recitations are structural limitations or mere statements of purpose or use "can be resolved only on review of the entirety of the [record] to gain an understanding of what the inventors actually invented and intended to encompass by the claim." Corning Glass Works, 868 F.2d at 1257, 9 USPQ2d at 1966. If the body of a

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claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). See also *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) ("where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation"). MPEP 2111.02. Thus, the recitation "for use in contact with flesh of an animal" is considered to be a mere intended use of a composite panel of the presently claimed invention.

Regarding recitations "the elements optically responsive to both wavelengths of ambient light and energy produced by an animal's body, to interact with the animal in a manner to increase oxygenated blood flow through cell structure of the flesh" and "wherein the composite panel is intended for use, and is structured to wick moisture from the animals body through the panel, and to allow air flow through the panel to the animal's body", applicant is reminded that article claims must be structurally distinguishable from the prior art. While features of an article may be recited either structurally or functionally, claims directed to an article must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997).

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Hiles teaches a light weight energy absorbing and damping device, which is a composite of foamed element and at least one visco-elastic element (Abstract). The invention of Hiles is directed to footwear, gloves etc. (column 1, lines 20-25). Hiles discloses an insole comprising a foam element having visco-elastic elements and a liner comprising a fabric, leather or other suitable material (Column 5, lines 1-6). As shown in the Figure 2, the liner 4 of the insole will come directly in contact with the animal's flesh as instantly claimed. The examiner is equating the liner 4 of Hiles as the claimed conformal layer comprising fibers as claimed in the present invention. Moreover, the composite (insole) of Hiles is air and moisture permeable (Column 3, lines 24-27).

Hiles is silent as to teaching of fibers comprising phase change material (PCM) and wherein the PCM is chosen to be a material for which the phase change temperature is about 95°F. However, Bryant et al. disclose a fabric coated with a layer of phase change material to regulate the temperature and keep the wearer cool and comfortable (Column 4, lines 9-14, Column 5, lines 25-28). The invention of Bryant is applicable to shoes and environmental suits (Column 5, lines 25-26). Additionally, Bryant et al. teach a PCM with the phase change temperature of 36.5°C (95°F) at (Column 3, line 61). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the fabric of Bryant coated with the PCM with the phase change temperature of 95°F in the invention of Hiles, motivated by the desire to provide comfort to a wearer of the footwear.

Hiles is silent as to teaching of fibers comprising rare earth elements. However, Widdemer teaches products such as gloves, shoes, and garments. According to

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Widdemer, a leather made beneficially interactive with the human body through the insertion of rare earth elements and/or ceramics into its fiber matrix for use in garments, footwear, gloves or upholstery (abstract). Further Widdemer teaches that it is known that certain rare earth elements reflect and amplify radiation such as laser beams and other wavelength of light (Paragraph 0002). Moreover according to Widdemer, when in proximity to the human body the rare earth elements interact with the human body such that it creates inner warmth in the human body and concurrently an increased blood flow (Paragraph 0002). The increase in blood flow provides more energy to muscles and generally promotes well being of an individual (Paragraph 0002). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the rare earth elements of Widdemer in the fabric of Hiles, motivated by the desire to provide comfort and general well being to a wearer of the footwear.

5. Claims 30,32, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ricken (US 4,974,397) in view of Bryant et al. (US 5,366,801), and further in view of Widdemer (US Patent Application Publication 2002/0035755).

Ricken teaches an anti-stress saddle pad formed of multiple layers of material (see Abstract). The saddle pad contains layers from top to bottom as follows: (a) a sheet of felt, (b) a sheet of visco-elastic polymer, (c) a sheet of open-celled polyurethane foam, and (d) a sheet of felt. Further Ricken teaches the visco-elastic polymer and the open cell polyurethane foam absorb shocks and vibrations (Column 1, lines 51-59). With respect to claim 33, although Ricken does not explicitly teach the weight of the shock absorbing visco-elastic or open-cell material to be 7 pound, it is the

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examiner's position that since the invention of Ricken has the same utility (i.e. a saddle pad) as the applicant, the visco-elastic polymer or the foam of Ricken necessarily has weight of 7 pound in order to successfully practice the instantly claimed invention.

Ricken is silent as to teaching of fibers comprising phase change material (PCM) as claimed in claim 26. However, Bryant discloses a fabric coated with a layer of phase change material to regulate the temperature and keep the wearer cool and comfortable (Column 4, lines 9-14, Column 5, lines 25-28). Note that Bryant is concerned with obtaining a fabric coated with the phase change material in order to regulate the temperature. The applicant is also concerned with providing a product with sophisticated temperature management (see Specification Page 3). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the phase change material of Bryant to the felt sheet of Ricken, motivated by the desire to keep the horse cool and comfortable.

Ricken is silent as to teaching of fibers comprising rare earth elements, however Widdemer teaches products such as gloves, shoes, and garments. According to Widdemer, a leather made beneficially interactive with the human body through the insertion of rare earth elements and/or ceramics into its fiber matrix for use in garments, footwear, gloves or upholstery (abstract). Further Widdemer teaches that it is known that certain rare earth elements reflect and amplify radiation such as laser beams and other wavelength of light (Paragraph 0002). Moreover according to Widdemer, when in proximity to the human body the rare earth elements interact with the human body such that it creates inner warmth in the human body and concurrently an increased blood

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flow (Paragraph 0002). The increase in blood flow provides more energy to muscles and generally promotes well being of an individual (Paragraph 0002). Note that Widdemer is concerned with providing a leather fabric with a better temperature stabilization. The applicant is also concerned with providing a product with sophisticated temperature management by absorbing the heat generated by the body of the horse and/or rider (see Specification Page 3). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the rare earth elements of Widdemer in the felt layer of Ricken, motivated by the desire to provide comfort and promote general well being of an animal.

### ***Response to Arguments***

6. Applicant's arguments filed 06/20/06 have been fully considered but they are not persuasive.

The applicant argues that in rejection of claim 26, the examiner has provided three references but very little insight into any motivation from any one of the references for making the combination. Further, the applicant argues that there must be some motivation for making the combination. The examiner respectfully disagrees. The examiner respectfully directs applicant's attention to pages 6 and 7 of 02/21/06 Office action, where the examiner has clearly stated the motivation to combine each of the cited references. Further note that Under Section 103, the obviousness of an invention cannot be established by combining the teachings of the prior art references absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed.



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Cir. 1984). **This does not mean that the cited prior art references must specifically suggest making the combination.** *B.F. Goodrich Co. M Aircraft Braking Systems Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996); *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988)). Rather, the test for obviousness is what the combined teachings of the prior art references would have suggested to those of ordinary skill in the art. *In re Young*, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). **This test requires us to take into account not only the specific teachings of the prior art references, but also any inferences which one skilled in the art would reasonably be expected to draw therefrom.** *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

Further in the applicant's response the examiner notes that although the applicant has generally disagreed with the 103 rejections by alleging "there is no motivation in several references cited to make this combination and no need in any one of the individual references for the missing characteristics" however the applicant has not explicitly pointed out supposed errors in the examiner's rejection. The examiner respectfully reminds the applicant that the rejections based on 103 cannot be simply overcome by merely arguing that there is no motivation in several references cited by the examiner to make the combination or that there is no need in any one of the individual references for the missing characteristics, the applicant should point out the supposed errors in the rejection.

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***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Desai whose telephone number is 571-272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

apd

  
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